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ART UNIT	PAPER NUMBER
2154	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/921,659	SHERWOOD, AMY L.
	Examiner	Art Unit
	Ashok B. Patel	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 August 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-34</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-34</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-34 are subject to examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

08/30/2005 has been entered.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-34 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1, 3-8, 15-22 and 29-34 are rejected under 35 U.S.C. 102(b) as being

anticipated by Williams (US 5,057,935).

Referring to claim 1,

Williams teaches a method for selectively applying a delivery notification option to an

email (Abstract) comprising:

listing email addresses (Fig. 2);

selecting a plurality of said email addresses in the course of composing an

email message (col. 1, line 58-63, Abstract)

maintaining a first list for a first type of delivery notification option (Fig. 2, element

46) and a second list for a second type of delivery notification option (Fig. 2, element 42

and 44);

selectively applying the delivery notification option to one or more, but not all, of

said plurality of email addresses;(Abstract, "In a preferred embodiment of the present

invention, a document may be transmitted to a plurality of recipients and the originator

may be permitted to require confirmation of the identity of the actual recipient for only

selected ones of that plurality of recipients.")

moving each of the one or more email addresses with a delivery notification

option applied to it into the first list, second list. or both lists corresponding to the

selected delivery notification option; and sending the email to said plurality of email

addresses..(col. 3, line 66 through col. 4, line 10).

Referring to claims 3 and 4,

Williams teaches a method of claim 1, further comprising sending a separate

email for a group of addresses that have the same delivery notification option

configuration, and the method of claim 1, further comprising sending a separate email to

each address of said plurality of addresses. (Fig. 2, col. 4, line 25-39," Referring again

to block 44, in the event the originator of an electronic document has designated the document under consideration as a document for which confirmation of the actual identity of the recipient is desired, the procedure passes to block 46. Block 46 depicts the entering of the document identity and the identity of the intended recipient in a status log. Those skilled in the art will appreciate that such status logs provide an efficient manner whereby the status of a large number of documents may be maintained. Thereafter, as above, block 48 is utilized to illustrate a determination of whether or not any additional documents must be processed. In the event the last document has been processed, the procedure again terminates, as illustrated in block 50.")

Referring to claim 5,

Williams teaches the method of claim 1, further comprising selectively applying more than one delivery notification option to one or more, but not all, of said plurality of email addresses. (col. 2, line 16-35,"In accordance with the method of the present invention, a confirmation of delivery status log entry is created upon the transmittal of a document to an intended recipient. Thereafter, the data processing system automatically determines the identity of the actual recipient of the document and generates a confirmation of delivery message which includes an identification of the actual recipient of that document. This confirmation of delivery, as well as the identity of the actual recipient, may be stored within the confirmation of delivery status log so that the originator of the document may, by reference thereto, accurately determine the identity of the actual recipient who provoked the confirmation of delivery message. In a preferred

embodiment of the present invention, a document may be transmitted to a plurality of recipients and the originator may be permitted to require confirmation of the identity of the actual recipient for only selected ones of that plurality of recipients.)

Referring to claims 6 and 7,

Williams teaches the method of claim 1, further comprising saving a configuration of delivery notification option settings that is associated with a first set of addresses, and the method of claim 6, further comprising matching a second set of addresses with the first set of addresses and automatically setting delivery notification options saved with respect to the first set of addresses. (col. 2, line 16-35, Fig. 2)

Referring to claim 8,

Williams teaches the method of claim 1, wherein the delivery notification option is selected from the options of delivery confirmation and return receipt. (Abstract).

Referring to claim 15,

Claim 15 is a claim to an email system that carries out the method of claim 1. Therefore claim 15 is rejected for the reasons set forth for claim 1.

Referring to claim 16,

Williams teaches the system of claim 15, further comprising means for listing email addresses on a computer screen. (col. 5, line 30-39, "As those skilled in the art will appreciate upon reference to the foregoing, the method of the present invention permits an originator of an electronic document to transmit that document to a plurality of recipients, who are identified within an addressee listing. Thereafter, the originator may

require confirmation of the actual identity of the recipient who triggered the confirmation

of delivery message for each of the listed intended recipients.")

Referring to claims 17 and 18 ,

Claims 17 and 18 are claims to an email system that carries out the method of claims

3 and 4. Therefore claims 17 and 18 are rejected for the reasons set forth for claims 3

and 4.

Referring to claim 19,

Claim 19 is a claim to an email system that carries out the method of claim 5.

Therefore claim 19 is rejected for the reasons set forth for claim 5.

Referring to claims 20 and 21,

Claims 20 and 21 are claims to an email system that carries out the method of claims

6 and 7. Therefore claims 20 and 21 are rejected for the reasons set forth for claims 6

and 7.

Referring to claim 22,

Claim 22 is a claim to an email system that carries out the method of claim 8.

Therefore claim 22 is rejected for the reasons set forth for claim 8.

Referring to claim 29,

Williams teaches an email system for selectively applying delivery notification options to

an email having a plurality of addressees (Abstract), comprising: an email client

operable to display an address list and to select addressees for an email (col. 5, line 30-

39,"As those skilled in the art will appreciate upon reference to the foregoing, the

method of the present invention permits an originator of an electronic document to

transmit that document to a plurality of recipients, who are identified within an addressee listing. Thereafter, the originator may require confirmation of the actual identity of the recipient who triggered the confirmation of delivery message for each of the listed intended recipients."); and

an email server in communication with the email client and connected to a network; wherein at least one of the email client and the email server is operable to selectively apply a delivery notification option to one or more, but not all, of the addressees (Figs. 1, 2 and 3) and

wherein at least one of the email client and the email server is further operable to maintain a first list for a first type of delivery notification option and a second list for a second type of delivery notification option; and to move each of the one or more email addresses with a delivery notification option applied to it into the first lists second list, or both lists corresponding to the selected delivery notification option. (Fig. 2, elements 42, 44 and 46, col. 3, line 66 through col. 4, line 10).

Referring to claims 30 and 31,

Williams teaches the email system of claim 29, wherein one of the email client and email server sends a separate email for a group of addressees that have the same delivery notification option configuration, and the email system of claim 29, wherein one of the email client and email server generates and sends a separate email to each addressee. . (Fig. 2, col. 4, line 25-39," Referring again to block 44, in the event the originator of an electronic document has designated the document under consideration as a document for which confirmation of the actual identity of the recipient is desired,

the procedure passes to block 46. Block 46 depicts the entering of the document

identity and the identity of the intended recipient in a status log. Those skilled in the art

will appreciate that such status logs provide an efficient manner whereby the status of a

large number of documents may be maintained. Thereafter, as above, block 48 is

utilized to illustrate a determination of whether or not any additional documents must be

processed. In the event the last document has been processed, the procedure again

terminates, as illustrated in block 50.")

Referring to claims 32 and 33,

Williams teaches the email system of claim 29, wherein one of the email client and

email server saves a configuration of delivery notification option settings that is

associated with a first set of addressees, and the email system of claim 32, wherein one

of the email client and email server matches a second set of addressees with the first

set of addressees and automatically sets delivery notification options saved with respect

to the first set of addressees. (col. 2, line 16-35, Fig. 2)

Referring to claim 34,

Williams teaches the email system of claim 29, wherein the delivery notification options

comprise delivery confirmation and return receipt. (Abstract).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 2, 9-14 and 23-28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Williams (US 5,057,935) in view of Gupta (US 2002/0194341 A1)

Referring to claim 2,

Williams teaches the method of claim 1, further comprising: selectively applying more

than one delivery notification option to one or more, but not all, of said plurality of email

addresses (Abstract," In accordance with the method of the present invention, a

confirmation of delivery status log entry is created upon the transmittal of a document to

an intended recipient. Thereafter, the data processing system automatically determines

the identity of the actual recipient of the document and generates a confirmation of

delivery message which includes an identification of the actual recipient of that

document. This confirmation of delivery, as well as the identity of the actual recipient,

may be stored within the confirmation of delivery status log so that the originator of the

document may, be reference thereto, accurately determine the identity of the actual

recipient who provoked the confirmation of delivery message");

       saving a configuration of delivery notification option settings that is associated

with a first set of addresses; matching a second set of addresses with the first set of

addresses and automatically setting delivery notification options saved with respect to

the first set of addresses(col. 2, line 16-35, Fig. 2);

       selecting the delivery notification option from the options of delivery confirmation

and return receipt; and sending a separate email to each address of said plurality of

addresses. (Abstract and (Fig. 2, col. 4, line 25-39," Referring again to block 44, in the

event the originator of an electronic document has designated the document under

consideration as a document for which confirmation of the actual identity of the recipient

is desired, the procedure passes to block 46. Block 46 depicts the entering of the

document identity and the identity of the intended recipient in a status log. Those skilled

in the art will appreciate that such status logs provide an efficient manner whereby the

status of a large number of documents may be maintained. Thereafter, as above, block

48 is utilized to illustrate a determination of whether or not any additional documents

must be processed. In the event the last document has been processed, the procedure

again terminates, as illustrated in block 50.")

Although, Williams clearly discloses and elucidates the listing email addresses,

Williams specifically fails to teach displaying an address book with the listed email

addresses; setting a flag indicating that more than one address has been chosen;

displaying an email delivery notification options selection window if said flag is set

wherein the email delivery notification options selection window permits selection of

delivery option.

Gupta teaches the interface in Fig. 5 displaying an address book with the listed

email addresses; setting a flag indicating that more than one address has been chosen;

displaying an email delivery notification options selection window if said flag is set

wherein the email delivery notification options selection window permits selection of

delivery option. (Page 5, para. [0058] and [0059]," One tab includes selectable options

through which the user may designate the closing information, stationery, whether to

use spell check, and the like, with electronic mail messages set to this contact. To

select the closing information and stationery, the user need only select the virtual "down

arrow" button to receive a listing of the possible closing messages and stationeries.

This listing may include a "none" option as well as a "default" option in addition to

customized options that have been defined by the user.   Moreover, the listing may

further include an option to generate new closing information for this contact, as will be

discussed in greater detail hereafter..")

Therefore, it would have been obvious to one having ordinary skill in the art at the time

of invention was made to use the interface provided by Gupta in order to implement the

system depicted in the Williams flow charts of Fig. 2 and Fig. 3 since Gupta's interface

tremendously assist and facilitates selectively applying options to addresses as desired

by Williams.

Referring to claim 9,

Williams teaches a method of selectively applying a delivery notification option to

addressees in an email (Abstract), comprising:

    maintaining a first list for a first type of delivery notification option (Fig.2, element

46) and a second list for a second type of delivery notification option (Fig. 2, element 42

and 44);

    selectively applying delivery notification options to each of the addressees

(;(Abstract, "In a preferred embodiment of the present invention, a document may be

transmitted to a plurality of recipients and the originator may be permitted to require

confirmation of the identity of the actual recipient for only selected ones of that plurality

of recipients.");

    moving each of the one or more email addresses with a delivery notification

option applied to it into the first list, second lists or both lists corresponding to the

selected delivery notification option and sending the email.(col. 3, line 66 through col. 4,

line 10).

Although, Williams clearly discloses and elucidates the listing email addresses,

Williams specifically fails to teach displaying an address book; choosing addressees

from the address book; setting a flag indicating that more than one addressee has been

chosen; displaying an email delivery options selection window if said flag is set.

Gupta teaches the interface in Fig. 5 displaying an address book; choosing

addressees from the address book; setting a flag indicating that more than one

addressee has been chosen; displaying an email delivery notification options selection

window if said flag is set. (Page 5, para.[0058] and [0059]," One tab includes selectable

options through which the user may designate the closing information, stationery,

whether to use spell check, and the like, with electronic mail messages set to this

contact. To select the closing information and stationery, the user need only select the

virtual "down arrow" button to receive a listing of the possible closing messages and

stationeries. This listing may include a "none" option as well as a "default" option in

addition to customized options that have been defined by the user. Moreover, the listing

may further include an option to generate new closing information for this contact, as

will be discussed in greater detail hereafter.")

Therefore, it would have been obvious to one having ordinary skill in the art at

the time of invention was made to use the interface provided by Gupta in order to

implement the system depicted in the Williams flow charts of Fig. 2 and Fig. 3 since

Gupta's interface tremendously assist and facilitates selectively applying options to addresses as desired by Williams.

Referring to claim 10,

Williams teaches the method of claim 9, wherein the email delivery notification options of at least one of delivery confirmation and return receipt. (Abstract), however Williams fails to specifically teach selection window.

Gupta teaches selection window (Page 5, para.[0058] and [0059]," One tab includes selectable options through which the user may designate the closing information, stationery, whether to use spell check, and the like, with electronic mail messages set to this contact. To select the closing information and stationery, the user need only select the virtual "down arrow" button to receive a listing of the possible closing messages and stationeries. This listing may include a "none" option as well as a "default" option in addition to customized options that have been defined by the user. Moreover, the listing may further include an option to generate new closing information for this contact, as will be discussed in greater detail hereafter.")

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to use the interface provided by Gupta in order to implement the system depicted in the Williams flow charts of Fig. 2 and Fig. 3 since Gupta's interface tremendously assist and facilitates selectively applying options to addresses as desired by Williams.

Referring to claims 11 and 12,

Williams teaches method of claim 9, further comprising sending a separate email for a

group of addressees that have the same delivery notification option configuration and

The method of claim 9, further comprising sending a separate email to each addressee.

(Fig. 2, col. 4, line 25-39," Referring again to block 44, in the event the originator of an

electronic document has designated the document under consideration as a document

for which confirmation of the actual identity of the recipient is desired, the procedure

passes to block 46. Block 46 depicts the entering of the document identity and the

identity of the intended recipient in a status log. Those skilled in the art will appreciate

that such status logs provide an efficient manner whereby the status of a large number

of documents may be maintained. Thereafter, as above, block 48 is utilized to illustrate

a determination of whether or not any additional documents must be processed. In the

event the last document has been processed, the procedure again terminates, as

illustrated in block 50.")

Referring to claims 13 and 14,

Williams teaches the method of claim 9, further comprising saving a configuration of

delivery notification option settings that is associated with a first set of addressees, and

the method of claim 13, further comprising matching a second set of addressees with

the first set of addresses and automatically setting delivery notification options saved

with respect to the first set of addressees. (col. 2, line 16-35,Fig. 2)

Referring to claim 23,

Claim 23 is a claim to an email system that carries out the method of claim 9.

Therefore claim 23 is rejected for the reasons set forth for claim 9.

Referring to claim 24,

Claim 24 is a claim to an email system that carries out the method of claim 10.

Therefore claim 24 is rejected for the reasons set forth for claim 10.

Referring to claims 25 and 26,

Claims 25 and 26 are claims to an email system that carries out the method of claims

11 and 12. Therefore claims 25 and 26 are rejected for the reasons set forth for claims

11 and 12.

Referring to claims 27 and 28,

Claims 27 and 28 are claims to an email system that carries out the method of claims

13 and 14. Therefore claims 27 and 28 are rejected for the reasons set forth for claims

13 and 14.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.
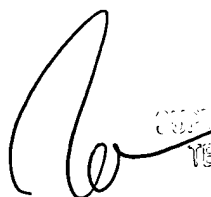
Although the specified citations are representative of the teachings of the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing responses,

to fully consider the references in entirety as potentially teaching all or part of the

claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp
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